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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/523,785
Confirmation No. : 5731
Applicant : Andrea Seger
Filed : Feb. 9, 2005
Title : Method for operating a field device
TC/A.U. : 2176
Examiner : D. D. Song
Docket No. : SEGE3004/FJD
Customer No. : 23364

PETITION TO WITHDRAW FINALITY OF OFFICE ACTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
ATTN: OFFICE OF PETITIONS

Sir:

Pursuant to the provisions of 37 CFR 1.181, applicants, by counsel, respectfully requests that the finality of the Office Action of January 22, 2010 be withdrawn.

STATEMENT OF FACTS

- 1) On August 1, 2008 the examiner issued an Office Action finally rejecting claims 10 - 18.
- 2) On December 1, 2008, applicants filed an RCE with a corresponding RESPONSE by which claim 10 was amended to include the subject matter of claim 11.
- 3) On January 28, 2009, the examiner issued an initial, but not final Office Action in this RCE application rejecting claims 10 and 12 - 18.
- 4) On April 28, 2009, applicants filed a RESPONSE to the Office Action of January 28, 2009. The claims were not further amended.

5) On July 31, 2009 the examiner issued an Office Action in which he finally rejected claims 10 and 12 - 18.

6) On November 2, 2009, applicants filed a further RCE and as RESPONSE by which claim 10 was amended to include the subject matter of claim 13 and to further amend claim 10 to define over the Forney et al reference.

7) On January 22, 2010 the examiner issued a first Office Action in the further RCE application, finally rejecting claims 10, 12 and 14 - 18, and to reject claim 10 under 35 USC 112, second paragraph as indefinite.

POINT TO BE REVIEWED

Is the finality of the rejection of claims 10, 12 and 14 - 18 over Forney et al when a new rejection under 35 USC 112, second paragraph, is also being made for the first time?

RELIEF SOUGHT

It is respectfully submitted that the finality of the rejection of claims 10, 12 and 14 - 18 is improper in view of the further new rejection of claim 10 under 35 USC 112, second paragraph, and should be withdrawn.

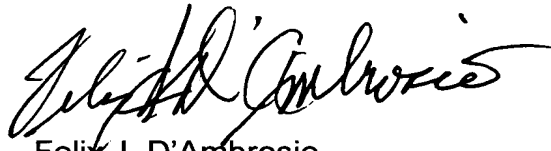
In making the rejection of claims 10, 12 and 14 - 18 over Forney et al final, the examiner cited MPEP § 706.07(b). This section of the MPEP states that finality on the first action in an RCE is proper when the " (A) [claims].....are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114, and (B).." Two conditions must be met, not just one. It is respectfully submitted, that condition "(A)" has not been met. By "same invention" is clearly meant a claim that has not been amended, which is not the case here. This understanding must be correct since "the same invention" once prosecution has proceeded to the point of an RCE cannot mean a different class of invention, since

that is never permitted at this stage of prosecution.

In addition the rejection under 35 USC 112, second paragraph could not have been made in the first RCE because the objected too phrases were not included in claim 10. They were introduced with the RESPONSE filed with the further RCE, and applicants should be given an opportunity to respond, which they would not have if the finality of the rejections stand.

For the reasons given the finality of the rejections should be withdrawn.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Felix J. D'Ambrosio', written in a cursive style.

Felix J. D'Ambrosio
Reg. No. 25,721

April 22, 2010

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